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10/805,706	03/22/2004	Oliver Hurst-Hiller	MSFT-2828/306400.01	8718

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER

STACE, BRENT S

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,706

Applicant(s)

HURST-HILLER ET AL.

Examiner

Brent S. Stace

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. Claims 1-18 have been examined. Claims 1-18 have been rejected. This document is the first Office action on the merits.

Information Disclosure Statement

2. The Information Disclosure Statement is being considered by the examiner.

Specification

3. The disclosure is objected to because of the following informality:
 - Paragraph [0035] (published paragraph [0039]) describes "By way of example only, FIG. 1 illustrates a hard disk drive 140 that reads from or writes to non-removable, nonvolatile magnetic media, a magnetic disk drive 151 that reads from or writes to a removable, nonvolatile magnetic disk 152, and an optical disk drive 155 that reads from or writes to a removable, nonvolatile optical disk 156, such as a CD ROM or other optical media" (emphasis added). The underlined areas above refer to incorrectly identified details of the figure. For example, detail 140 in Fig. 1 is not a hard disk drive.Appropriate correction is required.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 1, details 182, 184, 186. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the drawings. For example, the drawings should be carefully checked to ensure that all reference numerals are described in the specification, that no one reference numeral describes two separate drawing elements, or that the specification contains no reference to numerals not in the drawings.

Claim Objections

6. Claims 1-4, 8, 10, 11, and 18 are objected to because of the following informalities:

- a. Claim 1 recites "monitoring said search mechanism for search mechanism response data regarding said search;" on lines 7-8. This is a grammatical error. After this limitation there should be "and" to denote that this is the second to last limitation in the claim. This objection propagates downward through dependent Claims 2-4. Claims 3 and 11 recite this similar grammatical error in lines 2 and 9, respectively.
- b. Claim 8 recites "allowing explicit feedback should be collected in such a manner as to approximately reach said target value for how often explicit feedback is collected" in lines 5-6. This is poor sentence structure.
- c. Claim 10 recites "said user behavior data comprising data concerning at least one selected from among the following group: requery performed by said user, dwell time on said results page; click time on said results page; position of result clicked; more results requested by said user; result dwell time; result page size; or result page actions" in lines 6-9. It appears that the applicant is attempting to form a Markush group limitation. Regardless of if this is true or not, (although especially if it is true) all of the semi-colons above should instead be commas to be grammatically correct. Additionally, if the applicant is attempting to form a Markush group limitation, the correct format is "...selected from the group consisting of ____, ____, ..., and ____..." Claim 18 recites these similar objections.

- d. Claim 10 recites "where said search mechanism is adapted to perform a search in response to user" on lines 2-3. This is poor sentence structure.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-18 merely gather data. There is no useful tangible result. As such, the claims lack a practical application. The gathered data is not used to do anything.

9. Additionally, Claims 4 and 9 claim "a modulated data signal." Signals are non-statutory subject matter since they are not tangible.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4, 10-13, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0107843 (Biebesheimer et al.).

Claim 1 can be mapped to Biebesheimer as follows: "A method for gathering context-based user feedback for a search mechanism, [Biebesheimer, paragraph [0030] with Biebesheimer, paragraph [0035]] where said search mechanism is adapted to perform a search in response to user inputs, [Biebesheimer, paragraph [0032] with Biebesheimer, paragraph [0035] with Biebesheimer, paragraph [0038]] said method comprising:

- collecting user information from a user having access to said search mechanism; [Biebesheimer, paragraph [0030]]
- monitoring of said search mechanism for user behavior data regarding an interaction of said user with said search mechanism to perform a search; [Biebesheimer, paragraph [0042]]
- monitoring said search mechanism for search mechanism response data regarding said search; [Biebesheimer, paragraph [0042]]
- determining context-based user feedback data describing said search" [Biebesheimer, paragraph [0029]].

Claim 2 can be mapped to Biebesheimer as follows: "The method of claim 1, where said user information comprises one or more of the following:

- the speed of said user's connection to said search mechanism; [Biebesheimer, paragraph [0036]]
- the type of said user's connection to said search mechanism; [Biebesheimer, paragraph [0073]]
- a classification of said user's use of said search mechanism; [Biebesheimer, paragraph [0030] with Biebesheimer, paragraph [0073]]
- background information concerning said user; [Biebesheimer, paragraph [0030]]
or
- the language which said user is using to perform said search" [Biebesheimer, paragraph [0073]].

Claim 3 can be mapped to Biebesheimer as follows: "The method of claim 1, where said step of collecting said user information comprises:

- requesting said user information from said user; [Biebesheimer, paragraph [0030]]
- accepting responses from said user" [Biebesheimer, paragraph [0030]].

Claim 4 encompasses substantially the same scope of the invention as that of Claim 1, in addition to at least one of an operating system, a computer readable medium having stored thereon a plurality of computer-executable instructions, a co-processing device, a computing device, and a modulated data signal carrying computer executable instructions and some way(s) for performing the method steps of Claim 1. Therefore, Claim 4 is rejected for the same reasons as stated above with respect to Claim 1.

Claim 10 can be mapped to Biebesheimer as follows: "A method for gathering context-based user feedback for a search mechanism is implemented in a web browser, [Biebesheimer, paragraph [0030] with Biebesheimer, paragraph [0035]] where said search mechanism is adapted to perform a search in response to user, [Biebesheimer, paragraph [0032] with Biebesheimer, paragraph [0035] with Biebesheimer, paragraph [0038]] said method comprising:

- monitoring of said search mechanism for user behavior data regarding an interaction of user having access to said search mechanism with said search mechanism to perform a search, [Biebesheimer, paragraph [0042]] said user behavior data comprising data concerning at least one selected from among the following group: requery performed by said user, [Biebesheimer, paragraph [0027]] dwell time on said results page; click time on said results page; position of result clicked; more results requested by said user; result dwell time; result page size; or result page actions; [Biebesheimer, paragraph [0029]]
- monitoring said search mechanism for search mechanism response data regarding said search; [Biebesheimer, paragraph [0042]] and
- determining context-based user feedback data describing said search" [Biebesheimer, paragraph [0029]].

Claims 11-13 encompass substantially the same scope of the invention as that of Claims 1-3, respectfully, in addition to a system and some elements for performing the method steps of Claims 1-3, respectfully. Therefore, Claims 11-13 are rejected for the same reasons as stated above with respect to Claims 1-3, respectfully.

Claim 18 encompasses substantially the same scope of the invention as that of Claim 10, in addition to a system and some elements for performing the method steps of Claim 10. Therefore, Claim 18 is rejected for the same reasons as stated above with respect to Claim 10.

12. Claims 5 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,571,236 (Ruppelt).

Claim 5 can be mapped to Ruppelt as follows: "A method for gathering context-based user feedback for a search mechanism, [Ruppelt, cols. 3-4, lines 62-7] where said search mechanism is adapted to perform a search in response to user inputs, [Ruppelt, col. 3, lines 10-25] said method comprising:

- monitoring of said search mechanism for user behavior data regarding an interaction of a user having access to said search mechanism with said search mechanism to perform a search; [Ruppelt, col.2, lines 50-56]
- monitoring said search mechanism for search mechanism response data regarding said search; [Ruppelt, col. 3, lines 35-50]
- determining if explicit feedback should be collected, and if so, collecting explicit feedback data from said user; [Ruppelt, col. 3, lines 35-50] and
- determining context-based user feedback data describing said search, [Ruppelt, col. 4, lines 8-15] said context-based user feedback data comprising said explicit feedback data if said explicit user feedback data was collected" [Ruppelt, col. 3, lines 35-50 with Ruppelt, col. 4, lines 8-15].

Claim 9 encompasses substantially the same scope of the invention as that of Claim 5, in addition to at least one of an operating system, a computer readable medium having stored thereon a plurality of computer-executable instructions, a co-processing device, a computing device, and a modulated data signal carrying computer executable instructions and some way(s) for performing the method steps of Claim 5. Therefore, Claim 9 is rejected for the same reasons as stated above with respect to Claim 5.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 6-8 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,571,236 (Ruppelt) in view of U.S. Patent No. 6,434,547 (Mishelevich et al.).

For **Claim 6**, Ruppelt teaches: "The method of claim 5, where said step of determining if explicit feedback should be collected comprises."

Ruppelt discloses the above limitation but does not expressly teach:

- "determining if a snooze request is in effect from said user."

With respect to Claim 6, an analogous art, Mishelevich, teaches:

- "determining if a snooze request is in effect from said user" [Mishelevich, cols. 8-9, lines 62-5 with Mishelevich, cols. 10-11, lines 63-22].

It would have been obvious to one of ordinary skill in the art at the time of invention having the teachings of Mishelevich and Ruppelt before him/her to combine Mishelevich with Ruppelt because both inventions are directed towards user data entry.

Mishelevich's invention would have been expected to successfully work well with Ruppelt's invention because both inventions use computers for data entry, and they both monitor user behavior. Ruppelt discloses a method and apparatus for problem diagnosis and solution comprising collecting data from a user for enhancing a search. However, Ruppelt does not expressly disclose delaying the user from inputting data to be collected, and collecting feedback based on essentially, a quota for how often it should be collected. Mishelevich discloses a data capture and verification system comprising delaying user input and changing a user input prompting rate.

It would have been obvious to one of ordinary skill in the art at the time of invention having the teachings of Mishelevich and Ruppelt before him/her to take the delaying of user input and changing of a user input prompting rate from Mishelevich and install it into the invention of Ruppelt, thereby offering the obvious advantage of having a system that adapts to user input.

Claim 7 can be mapped to Ruppelt (as modified by Mishelevich) as follows: "The method of claim 6, where said step of determining if a snooze request is in effect from said user comprises:

- determining if said user has issued a snooze request; [Mishelevich, cols. 8-9, lines 62-5 with Mishelevich, cols. 10-11, lines 63-22] and
- determining if an associated time period associated with said snooze request has elapsed" [Mishelevich, cols. 8-9, lines 62-5 with Mishelevich, cols. 10-11, lines 63-22].

Claim 8 can be mapped to Ruppelt (as modified by Mishelevich) as follows: "The method of claim 5, where said step of determining if explicit feedback should be collected comprises:

- storing target data concerning a target value for how often explicit feedback should be collected for searches; [Mishelevich, col. 11, lines 5-10] and
- allowing explicit feedback should be collected in such a manner as to approximately reach said target value for how often explicit feedback is collected" [Mishelevich, cols. 10-11, lines 63-22].

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Claims 15-17 encompass substantially the same scope of the invention as that of Claims 6-8, respectfully, in addition to a system and some elements for performing the method steps of Claims 15-17, respectfully. Therefore, Claims 6-8 are rejected for the same reasons as stated above with respect to Claims 15-17, respectfully.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is advised that, although not used in the rejections above, prior art cited on the PTO-892 form and not relied upon is considered materially relevant to the applicant's claimed invention and/or portions of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent S. Stace whose telephone number is 571-272-8372 and fax number is 571-273-8372. The examiner can normally be reached on M-F 9am-5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brent Stace

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JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100